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OFFICE OF PETITIONS

In re Application of :
Peter Ralph : DECISION ON APPLICATION
Application No. 09/921,161 : FOR
Filed: August 1, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. GENENT.066A :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed June 23, 2005. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b)(3)(B)(i) be corrected from two hundred ninety-nine (299) days to five hundred seventy-two (572) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is five hundred seventy-two (572) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 2, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 299 days. Applicant timely submitted the instant application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 572 days. Applicant disputes the reduction of 104 days associated with their filing of a response to the restriction requirement mailed October 3, 2003. Applicant states that the response was

originally received in the Office on October 30, 2003, and re-faxed with proof of original filing on April 16, 2004. Thus, applicant contends that the October 30, 2003 date, not the April 16, 2004 date, should be used in assessing applicant delay. Furthermore, applicant contends that given that the response was received on October 30, 2003, a period of adjustment of 205 days should be entered for Office delay in not taking action in response until September 21, 2004. In support thereof, applicant submits their return postcard receipt.

The record supports a conclusion that the patent issuing from the application is not subject to a terminal disclaimer.

Applicant is correct. Applicant's properly itemized postcard is *prima facie* evidence of receipt in the Office of an "Amendment and Response to Restriction Requirement" on the date stamped thereon by the Office of Initial Patent Examination, October 30, 2003. This was within the three-month period for response to the restriction requirement mailed October 3, 2003. Thus, the reduction of 104 days is not warranted. Further, applicant is correct that it is appropriate to use the original date of receipt of the election in determining Office delay. Thus, an additional period of adjustment of 205 days is warranted for the Office delay from March 1, 2004 to September 21, 2004.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is five hundred seventy-two (572) days.

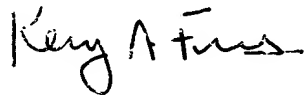
The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The Office has, thereby, forwarded the file to the Office of Patent Publication so that a patent can be issued. The patent term adjustment indicated on the patent will include any additional patent term accrued for Office delay in issuing the patent after the issue fee had been paid and all outstanding requirements met.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of

the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.



Kery A. Fries
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Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen